

DOCKET NO.: MSFT-2949/307005.01
Application No.: 10/775,624
Office Action Dated: May 28, 2008

PATENT

REMARKS

In summary, claims 1 and 5-33 were previously pending. Claims 1, 11, 19, 27, and 32 are independent. Claims 1, 7, 11, 15, 19-21, 23-27, 3,2 and 33 are herein amended while claims 6, 14, 22 are herein cancelled.

Office Action. Claims 6, 7, 14, 15, 22, and 23 are indicated to be allowable if rewritten in independent form. Claims 22 and 23 are objected to for an informality. Claims 1, 5-10, 19-26, 32, and 33 are rejected under 35 U.S.C. § 101. Claims 11-18 and 19-23 are rejected under 35 U.S.C. § 112 as indefinite. Claims 27 and 32 are rejected under 35 U.S.C. § 112 as indefinite. Claims 1, 5, 8-13, 16-21, and 24-33 are rejected under 35 U.S.C. § 103. Reconsideration of the objections and rejections in view of the foregoing amendments and following remarks is respectfully requested.

Telephone Conversation With Examiner

Examiner Wang is thanked for the telephone conversation conducted on August 7, 2008. Proposed claim amendments were discussed. Rejections under 35 U.S.C. §§ 101 and 112 were discussed. No agreements were reached.

Allowable Claims 6, 7, 14, 15, 22, and 23

Claims 6, 7, 14, 15, 22, and 23 are indicated to be allowable, but are objected to for their dependent form. Applicants thank the Examiner for the indication of allowable subject matter. Applicants elect to accept the allowable subject by incorporating the allowable subject matter into each of the five independent claims and canceling claims 6, 14, and 22. Each of the five independent claims was also amended to remove a prior amendment deemed inadequate by the Office Action.

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Objection to Claims 22 and 23 for an Informality

Claims 22 and 23 are objected to for an informality, i.e., claim 22 depending on claim 22. Claim 22 is herein cancelled. Accordingly, Applicants respectfully request withdrawal of the objection.

Rejection of Claims 1, 5-10, 19-26, 32 and 33 under 35 U.S.C. § 101

Claims 1, 5-10, 19-26, 32, and 33 are rejected under 35 U.S.C. § 101 allegedly for failing to claim statutory subject matter. Claims 1 and 5-10 are rejected for allegedly reciting “pure software modules” while claims 19-26, 32 and 33 are rejected for reciting “computer-readable medium” that may include communication media.

Without prejudice or disclaimer, claims 1, 5-10, 19-26, 32, and 33 are herein amended to indicate that the “software architecture comprises at least one computer readable storage medium storing computer executable instructions for . . .” Claims 19 and 32 are herein amended to recite “computer readable storage medium.” Accordingly, Applicants respectfully request withdrawal of the rejections.

Rejection of Claims 11-18 and 19-23 under 35 U.S.C. § 112

Claims 11-18 and 19-23 are rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to provide antecedent basis for “said detection.” (Office Action, p.3). Claims 11 and 19 are herein amended to provide antecedent basis for “said detection.” Accordingly, Applicants respectfully request withdrawal of the rejections.

Rejection of Claims 27 and 32 under 35 U.S.C. § 112

Claims 27 and 32 are rejected under 35 U.S.C. § 112, ¶ 2 as “being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.” Specifically, the Office Action states “It appears Applicant attempts to claim the invention as

disclosed in Figure 5, or specification, pages 15-16, for example. There are apparently some steps missing. For example, steps 501, 507, and 511.” (Office Action, p. 4.) Applicants respectfully traverse the rejection.

It is respectfully submitted that the Office Action misconstrues both the specification and the law pertaining to 35 U.S.C. § 112. While the Office Action asserts 35 U.S.C. § 112, ¶ 2 (indefiniteness), the argument actually falls under 35 U.S.C. § 112, ¶ 1 (written description). However, as is proven below, it doesn’t matter under which paragraph the rejection is categorized because it is without merit just the same.

The rejection alleging that “essential steps” are omitted from claims 27 and 32 is, in fact, an attack on the scope of the claims, i.e., a written description challenge under 35 U.S.C. § 112, ¶ 1. It is not, nor could it be, an attack under 35 U.S.C. § 112, ¶ 2 because "§ 112, ¶ 2 pertains only to claims. Agreement, or lack thereof, between the claims and the specification is properly considered only with respect to § 112, ¶ 1; it is irrelevant to compliance with § 112, ¶ 2." *Personalized Media Communications v. Int'l Trade Comm'n*, 161 F.3d 696, 706 (Fed. Cir. 1998), quoting *In re Ehrreich*, 590 F.2d 902, 906 (C.C.P.A. 1979) (emphasis added); see also MPEP § 2172, II (citing *In re Ehrreich*).

“[T]here is a subtle relationship between the policies underlying the description and definiteness requirements, as the two standards, while complementary, approach a similar problem from different directions. Adequate description of the invention [under 35 U.S.C. § 112, ¶ 1] guards against the inventor's overreaching by insisting that he recount his invention in such detail that his future claims [subsequent to original claims] can be determined to be encompassed within his original creation. The definiteness requirement [under 35 U.S.C. § 112, ¶ 2] shapes the future conduct of persons other than the inventor, by insisting that they receive notice of the scope of the patented device.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 1561 (Fed. Cir. 1991), citing *Rengo Co. v. Molins Mach. Co.*, 657 F.2d 535, 551 (3d Cir.), cert. denied, 454 U.S. 1055 (1981).

“The test for definiteness [under 35 U.S.C. § 112, ¶ 2] is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 [¶ 2] demands no more.” *Miles Laboratories, Inc. v. Shandon Inc.*, 997 F.2d 870, 875-76 (Fed. Cir. 1993) (citations omitted) (emphasis added); see also *Personalized Media*, 161 F.3d 696 at 705.

The “omitted element test” a/k/a “essential element test” is “not a correct statement of the law.” *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1347 (Fed. Cir. 2000) (Newman, J., concurring). “There is no ‘essential element’ test mandating an inquiry into what an inventor considers to be essential to his invention and requiring that the claims incorporate those elements.” *Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1323 (Fed. Cir. 2002); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1333 (Fed. Cir., 2003). “When the claim is supported by the patent’s disclosure . . . , neither law nor policy requires that the claim contain all elements described in the specification.” *Reiffin*, 214 F.3d at 1348 (Newman, J., concurring).

Written description analysis [under 35 U.S.C. § 112, ¶ 1] comparing claim scope to the disclosure is only utilized to compare subsequent claims to the disclosure to determine whether the original specification, including the original claims, discloses the subsequently claimed invention. *Texas Instruments Inc. v. ITC*, 871 F.2d 1054, 1062 (Fed. Cir. 1989) (“This is the essence of the description requirement of section 112, first paragraph: whether one skilled in the art, familiar with the practice of the art at the time of the filing date, could reasonably have found the ‘later’ claimed invention in the specification as filed.”) (emphasis added); *see also Reiffin*, 214 F.3d 1342 at 1347-48 (Newman, J., concurring); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 1562 (Fed. Cir. 1991).

“The claims as filed are part of the specification, and may provide or contribute to compliance with § 112.” *Hyatt v. Boone*, 146 F.3d 1348, 1352 (Fed. Cir. 1998), *cert. denied*, 525 U.S. 1141 (1999). Therefore, all originally filed claims automatically satisfy the written

description requirement as a matter of law. *Vas-Cath*, 935 F.2d at 1562 , citing *In re Smith*, 481 F.2d 910, 914 (C.C.P.A. 1973) (“Where the claim is an original claim, the underlying concept of insuring disclosure as of the filing date is satisfied, and the description requirement has likewise been held to be satisfied.”); see also *In re Koller*, 613 F.2d 819, 823-24 (C.C.P.A. 1980) (“original claims constitute their own description. Later added claims of similar scope and wording are described thereby.”); *In re Gardner*, 480 F.2d 879, 879-80 (C.C.P.A. 1973) (the original claim itself is considered an “adequate ‘written description’... whether located among the original claims or in the descriptive part of the specification”).

The presently pending claims 27 and 32 have the same steps as original claims 27 and 32. Since the original claims are part of the original disclosure, they satisfy the written description requirement. The written description expressly states that Figure 5 is merely an exemplary method. Nowhere do Applicants state that steps in Figure 5 are essential. The written description (i.e. the specification including original claims) is sufficient to enable those of ordinary skill to make and use the claimed subject matter, which need not include all elements or steps described in examples in the written description. “There is no ‘essential element’ test mandating an inquiry into what an inventor considers to be essential to his invention and requiring that the claims incorporate those elements.” *Cooper Cameron*, 291 F.3d at 1323.

Thus, it is respectfully submitted that both the first and second paragraphs of 35 U.S.C. § 112 are, clearly, fully satisfied by the specification and pending claims 27 and 32. Claims 27 and 32 clearly convey the scope of the invention to those of ordinary skill in the art, satisfying the second paragraph. The specification, which includes original claims 27 and 32, clearly describes the invention recited in presently pending claims 27 and 32, satisfying the first paragraph. By no stretch of the imagination can it be argued that Applicants convey in the original disclosure that claims 27 or 32 are unpatentable for failure to include “essential steps.” Original claims 27 and 32 and the remainder of the specification clearly convey precisely the opposite message to those of ordinary skill in the art. These claims, and the remainder of the specification, clearly set forth what Applicants regard as an invention. Additionally, despite the erroneous statement in

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M.P.E.P. § 2172.01, there is no “omitted element test” a/k/a “essential element test.” Further still, perceived differences between the disclosure and the claims are irrelevant to 35 U.S.C. § 112, ¶ 2. Therefore, for the aforementioned reasons, Applicants respectfully request that the rejection be withdrawn.

Rejection of Claims 1, 5, 8-13, 16-21 and 24-33 under 35 U.S.C. § 103

In response to previous amendments and remarks, the Examiner withdrew previous grounds of rejection, but asserts new grounds of rejection with new citations and arguments.

More specifically, claims 1, 5, 8-13, 16-21 and 24-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the alleged disclosure by an allegedly obvious combination of three references: (1) U.S. Patent No. 7,155,426 issued to Al-Azzawe (hereinafter referred to as “Al Azzawe”); (2) U.S. Patent No. 6,058,393 issued to Meier *et al.* (hereinafter referred to as “Meier”); and (3) U.S. Patent No. 7,107,578 issued to Alpern (hereinafter referred to as “Alpern”).

While Applicants traverse the rejections for several reasons, the present amendments incorporating allowable subject matter into every pending claim renders argument moot. At least in view of the present amendments, Applicant respectfully request withdrawal of the rejection of claims 1, 5, 8-13, 16-21 and 24-33 under 35 U.S.C. § 103(a).

Amendments made herein as well as amendments previously made are without abandonment of subject matter. Applicant expressly reserves the right to, in the pending application or any application related thereto, reintroduce any subject matter removed from the scope of claims by any amendment and introduce any subject matter not present in current or previous claims.

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CONCLUSION

In view of the foregoing remarks and amendments, it is respectfully submitted that this application is in condition for allowance. Reconsideration of this application and an early Notice of Allowance are requested.

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